

REMARKS

Claims 1, 3-6, 13-21 are pending. Applicants respectfully request reconsideration in view of the following remarks.

Objection to Specification

The specification was objected to as failing to provide proper antecedent basis for the term "computer-readable medium" in Claims 20 and 21. The Examiner has indicated on page 2 of the Office Action that "the proper reply would be to make a statement on the record that limits 'computer-readable medium' to statutory media only." Applicants thank the Examiner for her suggestion.

Applicants confirm that the term "computer-readable medium" is limited to statutory media only. Accordingly, withdrawal of the objection to the specification is respectfully requested.

Claim Rejections – 35 U.S.C. § 112

Claims 1, 13, and 20 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, it was asserted that the specification does not describe "movement of data" and a "associating ... the unique identifier associated with the first unique location identifier with a unique location identifier of a different data generating device." However, support for these terms may be found in at least paragraphs 9, 26, 28, and 386 of the specification.

For example, the specification describes "associating ... the unique identifier associated with the first unique location identifier ... in response to movement of data" as recited in Claim 1:

After recording information, the present invention tracks indices to locations of information. If the location of the device changes, that information could be tracked by the DDNS level 1 server so that queries could be automatically rerouted to the location at which the device is currently housed.

(Specification, ¶ 26 (p. 6, lines 10-14).)(emphasis added) The invention tracks indices to "locations of information." (*Id.*) Information may be generated by an individual device: "[i]ndividual devices create the namespace address necessary to retrieve information created by the individual device." (*Id.* at ¶ 28)(emphasis added) The information is stored and located on the device: "the present invention allows the minimal set of possible information at the top-level, which is used for routing requests for information, with actual information created by individual devices or sites stored and located at those devices or sites." (*Id.*)(emphasis added) If the location of a device changes, the location of the information stored on the device also changes. Consequently, paragraph 26 describes movement of data stored on a device when "the location of the device changes." Furthermore, in response to the movement of data, the new location of data "could be tracked by the DDNS level 1 server." (*Id.*) After the location of the device changes, "queries could be automatically rerouted to the [new] location." (*Id.*) Therefore, at least paragraph 26 of the specification describes the "movement of data" when the "location of the device changes."

The specification also describes "associating ... the unique identifier associated with the first unique location identifier with a unique location identifier of a different data generating device" as recited in Claim 1:

The DDNS system is driven by manipulation of names, by design permitting easy portability of machines within any organization. In this respect a namespace becomes a global variable to which a machine or machines become attached. Thus, for example, ddns-2.nyc.com could be a single machine, or a pointer to other machines; and/or the New York Hospital could change the type of machine supporting the ddns-2.nyc.com namespace without interrupting service to its local or global community.

(*Id.* at ¶ 386 (p. 41, lines 22-24; p. 42, lines 1-3).) (emphasis added) In the above example, the namespace address "ddns-2.nyc.com" is a unique identifier associated with the first unique location identifier of "a single machine." (*Id.*) The unique identifier may also be associated with a unique location identifier of "other machines." (*Id.*) Furthermore, the unique identifier may be associated with a different "type of machine." (*Id.*) The "other machines" and the different "type of machine" are different data generating devices. As noted above, "[i]ndividual devices create the namespace

address necessary to retrieve information created by the individual device." (*Id.* at ¶ 28) Thereafter, the "device driven unique identifiers ... identify objects that are the subject of transactions." (*Id.* at ¶ 9 (p. 3, lines 9-10).) (emphasis added) The "queries" referred to in paragraph 26 are one type of such transactions: "transactions provide genuinely global searching, retrieving, adding, and removing records from universal databases." (*Id.* at ¶ 75.) Therefore, paragraph 386 of the specification describes "associating ... the unique identifier associated with the first unique location identifier with a unique location identifier of a different data generating device" as recited in Claim 1.

The Federal Circuit has repeatedly held that "the specification must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation'." *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). Nevertheless, not everything necessary to practice the invention need be disclosed. MPEP §2164.08. How a teaching is set forth, by specific example or broad terminology, is not important. *In re Marzocchi*, 439 F.2d 220, 223-24 169 USPQ 367, 370 (CCPA 1971). Therefore the limitations of Claim 1 are fully enabled by the specification.

Additionally, the limitations of Claims 13 and 20 are fully enabled by at least the same paragraphs of the specification on similar grounds. Consequently, withdrawal of the Section 112 rejections of Claims 1, 13, and 20 is respectfully requested.

Claim rejections – 35 U.S.C. § 102

Claims 1, 3-6, 13-17 and 19-21 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,995,965 to Experton ("Experton"). As explained below, Experton does not describe all of the limitations recited in Claims 1, 3-6, 13-17 and 19-21.

CLAIM 1

For example, Experton fails to describe the limitations of Claim 1 of "associating, at the at least one server, the unique identifier associated with the first unique location identifier with a unique location identifier of a different data generating device in response to movement of data identified by the unique identifier to the different data generating device." (emphasis added) In sharp contrast, Experton describes "a central

list of user information sites ... maintained at one of the facilities or at some other agreed-upon site." (Col. 6, lines 12-14.) (emphasis added) The purpose of maintaining the list of user information sites is "to update data that is held in common." (Col. 6, line 11.) In other words, data stored in one facility is forced to be the same as similarly identified data stored in a second facility — which is the opposite of "associating ... the unique identifier associated with the first unique location identifier with a unique location identifier of a different data generating device in response to movement of data ... to the different data generating device." Note that if data, which is stored in a remote processing facility identified by a remote network address, were moved to a different remote processing facility, a smart card could no longer access the data, where the remote network address is stored in a smart card as it is in Experton. (See, Experton at Col 8, lines 36-36.) Therefore, Experton fails to describe the limitations of Claim 1.

Claims 3-6, 15, and 16 depend from Claim 1. Thus, Experton additionally fails to describe the limitations of Claims 3-6, 15, and 16.

CLAIM 13

Experton fails to describe all of the limitations of Claim 13. For example, Experton fails to describe the limitations of "the at least one server initiating a manipulation of an association of unique identifier and unique location identifier to change a unique identifier association from a unique location identifier of a first data generating device to a unique location identifier of a second data generating device, and instructing the first and second data generating devices regarding the change of unique identifier association." (emphasis added) Instead, Experton describes changing data records from an old value to a new value. (Col. 6, lines 8-19.) Experton is silent on changing any associations. Thus, Experton fails to describe "initiating a manipulation ... to change a unique identifier association from a unique location identifier of a first data generating device to a unique identifier of a second data generating device." Additionally, Experton fails to describe "instructing the first and second data generating devices regarding the change." Instead, changes to the records are uploaded to remote processing units. (Col. 8, lines 64-66.) Therefore, Experton fails to describe the limitations of Claim 13.

Claims 14, 17, and 19 depend from Claim 13. Thus, Experton also fails to describe the limitations of Claims 14, 17, and 19.

CLAIM 20

Experton also fails to describe the limitations in Claim 20. For example, Experton fails to describe the limitations of "associating the unique identifier ... with a unique location identifier of a different data generating device in response to movement of data ... to the different data generating device." (emphasis added) Instead, Experton describes "a central list of user information sites ... maintained at one of the facilities or at some other agreed-upon site." (Col. 6, lines 12-14.) (emphasis added) The purpose of maintaining the list of user information sites is "to update data that is held in common." (Col. 6, line 11.) In other words, data stored in one facility is forced to be the same as similarly identified data stored in a second facility — which is the opposite of "associating the unique identifier ... with a unique location identifier of a different data generating device in response to movement of data ... to the different data generating device." Therefore, Experton fails to describe all of the limitations of Claim 20.

Claim 21 depends from Claim 20. Thus Experton also fails to describe all of the limitations of Claim 21.

For at least the foregoing reasons, Experton fails to describe all of the limitations of Claims 1, 3-6, 13-17 and 19-21. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 102(e) rejections of Claims 1, 3-6, 13-17 and 19-21.

Claim rejections – 35 U.S.C. § 103

Claim 18 was rejected as obvious in view of the combination of Experton and U.S. Patent No. 5,345,586 to Hamala et al. ("Hamala"). Experton and Hamala, either separately or in combination, do not teach or suggest all of the recited limitations of Claim 18.

Claim 18 depends from Claim 13. As explained with regards to the 35 U.S.C. § 102 rejection of Claim 13, Experton fails to describe all of the limitations of Claim 13. The cited portions of Hamala also fail to describe the missing limitations. For example, Hamala fails to describe the limitations of "the at least one server initiating a manipulation of an association of unique identifier and unique location identifier to

change a unique identifier association from a unique location identifier of a first data generating device to a unique location identifier of a second data generating device, and instructing the first and second data generating devices regarding the change of unique identifier association." (emphasis added) Instead, Hamala describes a global data directory 50 that includes data model tables which may be used to manipulate heterogeneous data. (Col. 4, lines 55-63.)

For at least the foregoing reasons, neither Experton nor Hamala, alone or in combination, describe all of the limitations of the rejected claims. The assertion on Page 10-11 of the Office Action that the claimed invention would have been obvious to a person of ordinary skill in the art by combining Experton and Hamala, fails to establish a *prima facie* case of obviousness.

In order to establish a *prima facie* case of obviousness under 35 U.S.C 103(a), factual inquiries must be made according to *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966); MPEP §2141(II). The requirement to make these factual inquiries was recently affirmed by the Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. __, __, 82 USPQ2d 1385, 1391 (2007). Among these factual inquiries, "the scope and content of the prior art must be determined." *Graham*, 383 U.S. at __, 148 USPQ at 467; See MPEP §2141(II.A.). There is a burden of "factually supporting" any *prima facie* case of obviousness. MPEP §2142. Consequently, any determination of scope and content of the prior art must be factually supported.

As explained above, all of the claim limitations included in Claim 18 are not described in Experton and/or Hamala. Consequently, an assertion that the claim limitations are independently known in the cited references is factually unsupported. Accordingly, withdrawal of the 35 U.S.C. § 103 rejection of Claim 18 is respectfully requested.

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The present pending claims of this application are allowable and Applicants respectfully request the Examiner to issue a Notice of Allowance for this application. Should the Examiner deem a telephone conference to be beneficial in expediting allowance/examination of this application, the Examiner is invited to call the undersigned attorney at the telephone number listed below.

Respectfully submitted,
/Kent E. Genin/
Kent E. Genin
Attorney Reg. No. 37,834
Attorney for Applicant

KEG/MEH/sev

**BRINKS HOFER GILSON & LIONE
CUSTOMER NO. 00757**
Telephone: 312-321-7732
Facsimile: 312-321-4299